

Application Serial No. 10/581,953
Reply to Office Action of March 19, 2009

PATENT
Docket: CU-4850

REMARKS

In the Office Action, dated March 19, 2009, the Examiner states that Claims 1-12 are pending and rejected. By the present Amendment, Applicant amends the claims.

Rejections under 35 U.S.C. §112

Claims 1-2, 4-7 and 10 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Applicant indicates that the claims have been amended to clarify the paper materials of the surface layer-paper and base material layer-paper, and the relation between the three layers of the first impregnated paper layer and the second impregnated paper layer using such paper material, and the blocking layer. The claims have also been amended to clarify that the blocking layer is formed on the entire surface of the surface layer-paper. Accordingly, Applicant respectfully requests withdrawal of the present rejections under 35 U.S.C. §112, second paragraph.

Double Patenting

Claims 1-8 and 10 are rejected on the ground of nonstatutory obviousness-type double patenting over Claims 1-3 of US 6,514,624 in view of US 6,558,799 and over Claims 1-10 of US 6,558,799 in view of US 6,514,624. Included herewith this amendment is a terminal disclaimer, which limits the maximum allowable patent term for a patent granted from the present application to the maximum allowable patent term for US 6,514,624 and US 6,558,799. Accordingly, Applicant respectfully requests withdrawal of the present double patenting rejections.

Rejections under 35 U.S.C. §103(a)

Claims 1-8 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Takemoto (US 6,514,624) in view of Malina et al. (US 6,641,926). Claims 8-9 and 11-12 are rejected under 35 U.S.C. §103(a) as being unpatentable over Takemoto in view of Malina et al. and Rosenkranz et al. (US 4,339,566). Applicant respectfully disagrees with and traverses these rejections.

At the outset, Applicant indicates that the claims are amended to clarify that the thermosetting resin used for the first impregnated paper layer and the second impregnated paper layer are the same resin and the first impregnated paper layer is formed by permeating the surface layer-paper with the uncured thermosetting resin impregnated to the base material layer-paper.

Application Serial No. 10/581,953
Reply to Office Action of March 19, 2009

PATENT
Docket: CU-4850

Further, the thermosetting resin used for the first impregnated paper layer and the second impregnated paper layer of the decorative material recited in currently amended Claim 1 (present invention) are the same resin, and the thermosetting resin used for the first impregnated paper layer is the thermosetting resin permeated from the second impregnated paper layer. In other words, the first the second impregnated layer is formed by: carrying out a heat pressing shaping while contacting a surface layer-paper to a base material layer-paper with an uncured thermosetting resin impregnated with, permeating the uncured thermosetting resin from the base material layer-paper to the surface layer-paper, and curing the thermosetting resin contained in the base material layer-paper and the surface layer-paper (page 17, line 12 to page 18, line 15, of the specification).

In the present invention, since the thermosetting resin contained in both of the first and second impregnated paper layers is the same resin, and the thermosetting resin used for the first impregnated paper layer is the thermosetting resin permeated from the second impregnated paper layer, a decorative material excellent in bonding properties between the first and second impregnated paper layers can be obtained (page 17, line 25 to page 18, line 15).

In contrast, both of Takemoto (reference 1) and Malina (reference 3) are completely silent regarding the feature of the thermosetting resin contained in the impregnated paper layers being the same resin, and that the thermosetting resin used for one impregnated paper layer is the thermosetting resin permeated from the other paper base material impregnated with the uncured thermosetting resin.

This is also apparent from the disclosure of reference 2, for example, because the substrate with a decorative layer formed and the backing layer comprising the impregnated paper are separately produced and then bonded by a binding agent (column 2, line 18-29, of reference 3). Accordingly, even when reference 3 is combined with reference 1, Applicant respectfully asserts that it would be impossible to make the two impregnated paper layers excellent in bonding property like the present invention.

Further, the Office Action asserts that it is obvious to improve the bonding property of a layer by impregnating with a resin. However, when the thermosetting resin contained in the first impregnated paper layer is not a resin permeated from the base material layer-paper impregnated with the uncured thermosetting resin, the first

Application Serial No. 10/581,953
Reply to Office Action of March 19, 2009

PATENT
Docket: CU-4850

and second impregnated paper layer would not be able to exhibit their bonding properties fully.

In contrast, like the case of the present invention, when the thermosetting resin contained in the first impregnated paper-layer is the thermosetting resin permeated from the second impregnated paper layer, the layers can be made to the impregnated paper layers laminated with sufficient bonding properties.

As explained, sufficient bonding properties could not be obtained by simply impregnating the resin in the layer.

To support a *prima facie* case of obviousness, the Office Action must establish "a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference." Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57,526 (Oct. 10, 2007).

Since the cited prior art is silent regarding the feature of the thermosetting resin contained in the impregnated paper layers being the same resin, and that the thermosetting resin used for one impregnated paper layer is the thermosetting resin permeated from the other paper base material impregnated with the uncured thermosetting resin, Applicant respectfully asserts that a *prima facie* case of obviousness cannot presently be established.

Accordingly, Applicant respectfully requests withdrawal of the present rejections under 35 U.S.C. §103(a).

Application Serial No. 10/581,953
Reply to Office Action of March 19, 2009

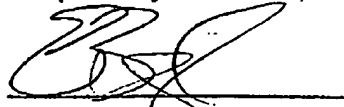
PATENT
Docket: CU-4850

In light of the foregoing response, all the outstanding objections and rejections are considered overcome. Applicant respectfully submits that this application should now be in condition for allowance and respectfully requests favorable consideration.

August 18, 2009

Date

Respectfully submitted,



Attorney for Applicant
Eric D. Babych
c/o Ladas & Parry LLP
224 South Michigan Avenue
Chicago, Illinois 60604
(312) 427-1300
Reg. No. 57,542